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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
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EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/918,326	HARRISON ET AL.	
	Examiner	Art Unit	
	Kevin Schubert	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-16 have been considered. Examiner has provided a new ground(s) of rejection, necessitated by amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Mazzagatte, U.S. Patent No. 6,862,583.

As per claim 10, the applicant describes a device comprising the following limitations which are met by Mazzagatte:

a) a store of digital certificates, each certificate being associated with a most recent sender of a received digital document (Col 8, line 20 to Col 10, line 40);

b) an audit log comprising a list of received document entries, each entry containing a reference to one of the certificates in the store and a unique identifier associated with a received digital document (Col 8, line 20 to Col 10, line 40);

c) the received digital document and a digital certificate of a most recent sender of the received digital document are received contemporaneously by the facsimile machine (Col 8, line 20 to Col 10, line 40);

d) the facsimile machine is configured to print the received digital document upon the most recent sender of the received digital document being authenticated (Col 8, line 20 to Col 10, line 40);

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Mazzagatte teaches a method of authenticated secure printing in which a print node receives and stores documents and corresponding certificates. The documents and certificates are received contemporaneously. The print node waits for an intended recipient to arrive at the printer and present proper authentication. Once the intended recipient is authenticated, the printer then determines whether there are any print jobs queued for the intended recipient, and the print node may accordingly print a document.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,9, and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte in view of Slick, U.S. Patent No. 7,003,667.

As per claims 1 and 11, the applicant describes a document printout device comprising the following limitations which are met by Mazzagatte in view of Slick:

a) a store of digital certificates, each certificate being associated with a received digital document and a most recent sender of the received digital document which is to be printed (Mazzagatte: Col 8, line 20 to Col 10, line 40);

b) an audit log comprising a list of received document entries, each entry containing a reference to one of the certificates in the store, an encrypted digest corresponding to the received digital document of that entry, and a unique identifier associated with the received digital documents (Mazzagatte: Col 8, line 20 to Col 10, line 40; Slick: Col 13, lines 9-25);

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c) a decryption algorithm for decrypting the received encrypted digest associated with one of the received digital documents selected for verification (Slick: Col 13, lines 9-25);

d) a hash algorithm for creating a digest of the selected digital document such that when the created digest corresponds to the decrypted digest, the digital certificate of the most recent sender is authenticated (Mazzagatte: Col 8, line 20 to Col 10, line 40; Slick: Col 13, lines 9-25);

e) the received digital document, the received encrypted digest associated with the received digital document, and the digital certificate associated with the received digital document are received contemporaneously (Mazzagatte: Col 8, line 20 to Col 10, line 40; Slick: Col 13, lines 9-25);

f) the document printout device is configured to print the received digital document upon the digital certificate of the most recent sender being authenticated (Mazzagatte: Col 8, line 20 to Col 10, line 40)

Mazzagatte fails to disclose that an encrypted digest may be sent with a digital document. Slick discloses that an encrypted digest may be sent because doing so allows for authentication and integrity verification purposes. It would have been obvious to combine the ideas of Slick with those of Mazzagatte because utilization of a digest allows for authentication and integrity verification purposes.

As per claims 2-3, the applicant describes the device of claim 1, which is met by Mazzagatte in view of Slick, with the following limitation which is met by Mazzagatte:

Wherein the device is arranged to carry out an on-line authentication of a received certificate held in the store of received documents (Mazzagatte: Col 8, line 20 to Col 10, line 40).

As per claim 4, the applicant describes the device of claim 1, which is met by Mazzagatte in view of Slick, with the following limitation which is met by Mazzagatte and Slick:

Wherein each entry in the audit log contains a digest of the received document to which it relates (Mazzagatte: Col 8, line 20 to Col 10, line 40; Slick: Col 13, lines 9-25).

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As per claim 9, the applicant describes the device of claim 1, which is met by Mazzagatte in view of Slick, with the following limitation which is met by Mazzagatte:

Wherein the unique identifier is an alphanumeric code and the device further comprises an input module for inputting the code to access the relevant entry in the audit log (Mazzagatte: Col 10, lines 12-24).

As per claims 12-16, the applicant describes the device according to claims 1 and 11, which are met by Mazzagatte in view of Slick, with the following limitation which is met by Slick:

Wherein each digital certificate comprises a public key associated with a sender of the received digital document; wherein the decryption algorithm decrypts the encrypted digest using the sender's public key extracted from the digital certificate; wherein the hash algorithm computes a digest of a document copy, and wherein authenticity of the copied document is verified when the computed digest corresponds to the decrypted digest (Slick: Col 16, lines 25-39).

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte in view of Slick in further view of Fischer, European Patent No. 0386867B1.

As per claim 5, the applicant describes a device according to claim 4, which is met by Mazzagatte in view of Slick, with the following limitation which is met by Fischer:

Further comprising a hash algorithm for creating a digest of a digital document and a receiving module for receiving a digital representation of a previously printed out document, wherein the device is arranged to create a digest of the digital representation of the previously printed out document and to compare the newly created digest with the corresponding digest stored in the audit log (Fischer: Page 17, lines 21-36).

Mazzagatte in view of Slick discloses all the limitations of claim 4. However, Mazzagatte in view of Slick fails to disclose the use of printing out a document and then scanning it back in to create a new digest for comparison of a stored digest. Fischer describes a system where a document that is printed

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out can be scanned back in. Upon doing this, a digest of it is created for comparison of it with a saved digital signature to make sure the document is genuine. In the case where a user wants to verify that a printed out document is authentic or was printed out at a particular machine, a newly created digest could be used to reference an audit record via a saved digest.

The newly created digest would be compared with saved digests, and if a match occurs, the corresponding audit record is pulled up which can verify whether the document was printed out at the particular machine and what time it was printed out for security or non-repudiation means. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the idea of Fischer with those of Mazzagatte in view of Slick because doing so further allows for integrity verification of a printed out document.

As per claim 6, the applicant describes a device according to claim 5, which is met by Mazzagatte in view of Slick in further view of Fischer, with the following limitation which is met by Fischer:

Wherein the device is arranged to send either a stored digest or a newly created digest of a document to its original sender to verify the authenticity of the document back to its source by considering the transmitted results of a comparison of digests carried out at the source (Fischer: Page 18, lines 29-36).

As per claim 7, the applicant describes a device according to claim 5, which is met by Mazzagatte in view of Slick in further view of Fischer, with the following limitation which is met by Fischer:

Wherein the receiving module is a document scanning module (Fischer: Page 17, lines 21-36).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte in view of Slick in further view of Mandelbaum, EP Patent No. 0671830A2.

As per claim 8, the applicant describes the device according to claim 1, which is met by Mazzagatte in view of Slick, with the following limitation which is met by Mandelbaum:

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Wherein each entry in the audit log contains the time and date of receipt of each digital document (Mandelbaum: Table 404 of Fig 4);

Mazzagatte in view of Slick disclose all the limitations of claim 1. However, Mazzagatte in view of Slick appear to be silent as to including a document time and date. Mandelbaum discloses that a document may be associated with a time and date. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Mandelbaum with those of Mazzagatte in view of Slick and include a time and date because doing so provides a number of benefits, including allowing a recipient to know how long a document has been queued.

Response to Arguments

Applicant's arguments with respect to the 102(e) and 103(a) rejections of claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KS


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER